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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------------|
| 10/522,212 | 01/14/2005 | Jean-Marie Adam | EL/2-22719/A/PCT | 3742 |
| 324 7590 10/03/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005 | | | EXAMINER CHUNG, SUSANNAH LEE | |
| | | | ART UNIT 1626 | PAPER NUMBER |
| | | | MAIL DATE 10/03/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/522,212 | Applicant(s) ADAM ET AL. | |
| | Examiner Susannah Chung | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 7-12, and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14 are pending in the instant application.

Priority

This application is a 371 of PCT/EP03/07638, filed 7/15/2003.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) by application no. EPO02405640.0 filed in the European Patent Office on 07/22/2002, which papers have been placed of record in the file. The application names an inventor or inventors named in the prior application.

Response to Election/Restrictions

Applicant's election with traverse of a group Applicant elected as Claims 4-6 and 13 in the reply filed on 09/17/2007 is acknowledged. Specially, the election of species of the compound of Example 5 and 6 on page 24 of the instant specification.

The reason for traversal is that there is a special technical feature linking the claims. Applicants argue that Claim 4 is the special technical feature linking the claims. Applicants arguments are acknowledged, but are not found persuasive. The compound of claim 4, formula (IV), is well known in the art and cannot be deemed a special technical feature that makes a contribution over the prior art. (See the following rejections in the instant action). Therefore because the special technical feature of claim 4 is well known in the art, the requirement is still deemed proper and is therefore maintained.

Scope of the Elected Invention

Claims 4-6 and 13 are pending in this application. Claims 1-3, 7-12, and 14-15 are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a

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non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Obviousness Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4-6 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

-Claims 1-3 of U.S. Patent No. 5,919,944;

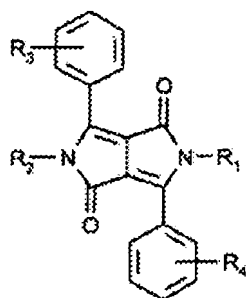
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-Claim 1 of U.S. Patent No. 6,107,491;

-Claims 3 and 12-14 of U.S. Patent No. 6,048,918

-Claims 1-7 of U.S. Patent No. 5,847,156

Applicants instant elected invention teaches the compound of formula (IV),

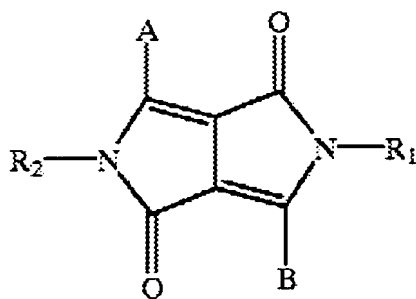
, depicted in claim 4, wherein **R1** and **R2** are -X2-X3, wherein

X₂ is an alkylene, arylene, aralkylene or cycloalkylene spacer containing optionally one or more groups -O-, -S-, -NR₁₄-, -CO-, -CONH-, -CONR₁₃-, or -COO- as linking bridge,

X₃ is OH, NH₂, -C(R₁₁)=CH₂, -OC(O)-C(R₁₂)=CH₂, -C(O)-C(R₁₂)=CH₂, or -OC(O)-N-X₄-N-C(O)-O-X₅-O-C(O)-C(R₁₂)=CH₂, wherein

Determination of the scope and content of the prior patent

U.S. Patent Nos. 5,847,156; 5,919,944; 6,048,918; and 6,107,491 teach compounds of



formula (I),

, wherein A and B are phenyl substituted by R3 and

R4; R1 is alkylene, arylene, aralkylene, or cycloalkylene spacers; and R2 is alkyl or cycloalkyl.

Ascertainment of the difference between the prior patent and the claims (MPEP § 2141.02)

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The main difference between the patents and the instant application is that formula (IV) in the instant application the core has two fixed phenyl rings, while in the prior art it is a variable and can be substituted with other than phenyl.

Finding of prima facie obviousness – rationale and motivation (MPEP § 2142-2413)

One skilled in the art would have found the claimed compound prima facie obvious because the instantly claimed compound and the compound in patents claim the same compounds. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity. Both the instantly claimed compounds and the compounds of the prior patents are used for the same purpose (i.e. to produce color effects).

Although, the instant application differs in that it specifically defines A and B as phenyl, versus the patents which are broader, one skilled in the art would have found this variation obvious when faced with the patents because the compounds have the same use. In addition, one skilled in the art would be able to make the instantly claimed compounds using the teachings of the prior patents.

The following is from MPEP 804:

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that: The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent. In re Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring).

Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982).

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Telephone Inquiry

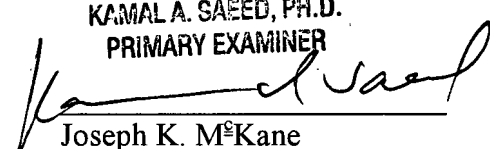

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098.

The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLC


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Date: 27 September 2007